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PATENT APPLICATION

ATTORNEY DOCKET NO. 200310639-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Alan C. Berkema

Confirmation No.: 9731

Application No.: 10/728,495

Examiner: Daniel L. Hoang

Filing Date: 12/5/2003

Group Art Unit: 2136

Title: Device pairing

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 5-13-2009.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

Respectfully submitted,

Alan C. Berkema

By: /Michael Dryja/

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First named Applicant: Alan C. Berkema	Group Art Unit:
Application No.: 10/728,495 (CONF 9731)	2136
Filed: 12/5/2003	
Title: Device pairing	Examiner:
Attorney Docket No.: 200310639-1	Daniel L. Hoang

Assistant Commissioner for Patents
Washington, D.C. 20231

REPLY BRIEF

Applicant files this reply brief in response to the Examiner's answer of May 13, 2009. Applicant organizes this brief as to the grounds of rejection A, B, C, and D initially presented in Applicant's appeal brief.

Ground of Rejection A

The ground of rejection A is whether claims 1, 2, 10-18, 21, 23-32, 4-49 were properly rejected under 35 USC 112, first and second paragraphs. In the appeal brief, Applicant explained how paragraphs [0034], [0049], and [0051] of the patent application as filed provide adequate support for generating a PIN in response to a local PIN request *without communicating with the claimant device*. Curiously, in his answer, the Examiner simply explained how *paragraph [0031]* of the patent application as filed does not support this limitation of the invention. Regardless of whether the Examiner's explanation as to paragraph [0031] is correct or not, the fact of the matter is that paragraphs [0034], [0049], and [0051] more than adequately provide support for this limitation of the invention. Namely, these paragraphs describe how a user presses a button on a given device (i.e., the local PIN request), and responsive thereto, a PIN is generated without there being any communication with another device (i.e., the claimant device). Therefore, for these reasons as discussed in great detail in the appeal brief, Applicant requests that the rejections under 35 USC 112, first and second paragraphs, be overturned.

Ground of Rejection B

The ground of rejection B is whether claims 1, 31, 48, and 49 were properly rejected under 35 USC 103(a) as being unpatentable over Willey (2003/0065918). In the appeal brief, Applicant explained how in paragraphs [0038]-[0049], Willey suggests that a PIN is generated *with communicating with the claimant device*, which is in contradistinction to the claimed invention, which requires that a PIN is generated *without communicating with the claimant device*. In the answer, the Examiner simply asserted that paragraph [0041] of Willey suggests that a PIN is generated without communicating with the claimant device (see p. 6, para. 5 of answer). The Examiner provided absolutely no explanation in this assertion, and provided no explanation as to why Applicant's interpretation is incorrect (see p. 11 of answer).

It is of course well settled law that that prior art rejection analysis has to "be conducted on a limitation by limitation basis, with specific fact findings for each contested limitation and *satisfactory explanations* for such findings" (Gechter v. Davidson, 43 USPQ2d 1030 (Fed. Cir. 1997)). The Examiner has ignored this requirement; he has provided absolutely *no explanation* for his finding, let alone a *satisfactory explanation* for his finding. Indeed, the Supreme Court has reiterated this requirement, holding that the Examiner is required to provide "*articulated reasoning with some rational underpinning* to support the legal conclusion of obviousness," in KSR Int'l Co. v. Teleflex, Inc., 550 US 298 (2007) (slip op. at 14). The Examiner has ignored this requirement as well; he has provided absolutely *no articulated reasoning* for his conclusion of obviousness, let alone reasoning that has *any rational underpinning*.

The Examiner has the obligation to advance a *prima facie* case of obviousness, pursuant to the requirements stated in the previous paragraph. The Examiner has grossly failed his obligation in this respect. He has provided no satisfactory explanation for his findings, and has not provided any articulated reasoning with rational underpinning for his conclusion of obviousness. Just for this reason, in addition to the fact that Willey does not suggest a PIN is generated without communicating with a claimant device as discussed in thorough detail in the appeal brief, Applicant requests that the rejections of claims 1, 31, 48, and 49 under 35 USC 103(a) be overturned.

Ground of Rejection C

The ground of rejection C is whether claims 2, 10-12, 40-42, and 48-49 were properly rejected under 35 USC 103(a) as being unpatentable over Willey in view of Slick (2003/0105963). As noted in the appeal brief, claims 2, 10-12, and 40-42 are dependent claims, depending from independent claims 1 and 31 that were rejected over Willey alone, as discussed above in relation to the ground of rejection B, and therefore are patentable at least because they depend from patentable base independent claims. As also noted in the appeal brief, independent claim 48 recites similar claim language as claim 1 does, and therefore is patentable over Willey in view of Slick for substantially the same reasons that claim 1 is patentable over Willey alone; as such, claim 49 is patentable at least because it depends from a patentable base independent claim, claim 49. Applicant therefore requests that the rejections of claims 2, 10-12, 40-42, and 48-49 under 35 USC 103(a) be overturned.

Ground of Rejection D

The ground of rejection D is whether claims 13, 15-18, 21, 23, 25-26, 28-30, 31-32, and 45-47 were properly rejected under 35 USC 103(a) as being unpatentable over Willey in view of Phillips. As noted above in relation to the ground of rejection B, Willey does not suggest the generation of a PIN without communicating with a claimant device (and indeed suggests the generation of a PIN with communicating with a claimant device). In the appeal brief, Applicant also explained how in column 7, lines 3-18, Phillips does not suggest anything approaching the generation of a PIN without communicating with a claimant device. Therefore, because neither Willey nor Phillips suggests this claim limitation, the combination of Willey in view of Phillips cannot suggest this limitation of the claimed invention. Applicant thus requests that the rejections of claims 13, 15-18, 21, 23, 25-26, 28-30, 31-32, and 45-47 under 35 USC 103(a) be overturned for at least substantially the same reasons discussed above in relation to the ground of rejection B.

First named inventor: Hanks
Serial no. 10/347,074
Filed 1/17/2003
Attorney docket no. 200210242-1

Page 4

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Michael Dryja", written over a horizontal line.

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July 12, 2009
Date

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